

REMARKS

This responds to the Office Action mailed on July 9, 2007.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 16-20 are now pending in this application.

Interview Summary

Applicants thank Examiner **Mark A. Fadok** for the courtesy of a telephone interview on **August 14, 2007** with paralegal for Applicants, **Peter Rebuffoni**. As noted by the Examiner during the interview, the Final Office Action did not specifically note the new grounds of rejection, and specifically omitted providing the statutory basis for rejecting each of the claims. The Examiner indicated during the interview that the new grounds for rejection were a rejection under 35 U.S.C. § 102(e) and a rejection under 35 U.S.C. § 103(a). No indication was provided as to which statute applied to which claims. The Examiner indicated during the interview that an Interview Summary would be mailed by the Examiner to provide the omitted information.

No such summary has been provided. Applicant respectfully requests that if such an Interview Summary provides material new information of grounds for rejection that a new date for response be set and that the finality of the rejection be withdrawn.

§102 Rejection of the Claims

Claims 16-19 were rejected under 35 U.S.C. § 102(e) for anticipation by Hu et al. (U.S. 7,197,465, hereinafter "Hu"¹). Applicants respectfully traverse the rejection for the reasons stated below.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation at least because Hu does not teach each and every claim element.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of

¹ Applicants note that Hu was "applied" in the Examiner's remarks but note that no mention was made of a statutory basis for the rejection. Applicants have treated the rejection, since it is based upon a single document, as an anticipation rejection.

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 16 includes, in part, the limitations of:

"...generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered and/or manually entered by the sender; and receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label," (Emphasis added)

In reviewing the portions of Hu relied upon by the Office Action it can be seen that Hu does not teach the highlighted elements of the above claim 16 limitations. The Office Action has cited Fig. 12 to support the rejection of the claim 16 limitation of "*generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered and/or manually entered by the sender.*"

Hu, at col. 15, lines 30-49 states that the User's information, in Fig. 12, is provided by the User and no shipping information is automatically entered.:

FIG. 12 is a graphic representation depicting an exemplary embodiment of a User address collection screen. As depicted in FIG. 12, the System prompts the User to provide the User's name 106 . . . As with the previous registration introduction screen 41, the Next 102, Reset 103, Cancel 104, and Help 105 buttons are provided with results similar in nature to the operations of these respective buttons as described above. In addition, a Back button 117 is provided. If the User clicks the Back button 117, the System returns the User to the screen from which the User entered the present screen . . . If the User clicks the Next button 102, the System performs validation edits on the data entered. If any required fields have not been completed, or if any fields contain data found to be in error, the System notifies the User and requests that corrected data be entered.² (Emphasis added)

In the cited passage, Hu's system prompts the User to provide information and if any required fields have not been completed, or if any fields contain data found to be in error, the System notifies the User and requests that corrected data be entered. However, the system in Hu does not teach *shipping information pertaining to the shipment may be automatically entered*, as required by claim 16. Thus, User's information, in Fig. 12, is provided by the User and no shipping information is automatically entered. Accordingly, Hu fails to disclose the limitation of

² Hu, col. 6, lines 30-49

“generating and serving web pages via which shipping information pertaining to the shipment may be automatically entered and/or manually entered by the sender,” as recited in claim 16.

The Office Action has also relied on Fig. 25 of Hu to reject the claim 16 which includes a limitation of *“receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label.”* As described by the following passage, Fig. 25 does not teach this limitation. Hu, in Col. 19, lines 6-14 states:

FIG. 25 is a graphic representation of an exemplary embodiment of a Create a Seller's Link Screen 52. Before the System can create a Seller's link, the User must tell the System information about the particular package that will be shipped. Accordingly, as depicted in FIG. 25, the System asks the User to enter the shipping weight and value of the item to be shipped 190. The User is asked to enter the Shipping Weight 191a.³
(Emphasis added)

According to the above cited passage from Hu, Fig. 25 is a Create a Seller Link Screen, where the User must tell the system information about the package. For example the system asks the User to enter the shipping weight and value of the item to be shipped. However, asking the User to enter the shipping weight and . . . is not the same as *receiving shipping data pertaining to the shipment from the shipping vendor*, specifically, the User in the context of the Create a Seller's Link is not the same as the claimed shipping vendor (see Hu, col. 18, lines 11-12, where it is stated “. . . User's client machine (Seller's computer) . . .”, that is to say, User is defined to be Seller). Thus, Hu's Fig. 25 fails to teach the limitation of *“receiving shipping data pertaining to the shipment from the shipping vendor, said shipping data including data corresponding to a shipping label,”* as recited in claim 16.

Therefore, at least for the reasons set forth above, Hu fails to teach each and every element of claim 16. As such, Applicants respectfully submit that rejection under 102(e) of independent claim 16 and its dependent claims 17-20 over Hu have been overcome. Thus, it is requested the claim rejections under 35 U.S.C. § 102(e) be withdrawn.

³ Hu, col. 19, lines 6-14

§103 Rejection of the Claims

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hu et al. in view of Official Notice.

In consideration of the above 35 U.S.C. § 103(a) rejection, in light of the arguments presented above with respect to claim 16, Hu fails to anticipate the independent claim 16, and therefore also does not disclose the subject matter of dependent claims 17-20 which each add additional limitations to claim 16.

First, Applicants believe that the taking of "official notice" here was inappropriate since it was first invoked when the application was already under final rejection. At MPEP 2144.03 A. it is said that while taking of "official notice" may be relied on "these circumstances should be rare when an application is under final rejection." In view of all of the above, Applicants respectfully request that Adequate Evidence be provided in accordance with 37 CFR 1.113(b). If the Examiner is relying on personal knowledge to support his assertion of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

Applicants respectfully submit that, no *prima facie* case of obviousness, for claim 20, based on Hu has been established. Applicants respectfully traverse, pursuant to MPEP 2144.03 and 37 CFR 1.113(b), the Examiner's taking of Official Notice that "the creation of a virtual credit card for use in payment for products or services was old and well known in the art at the time of the invention." Applicants assert that the taking of official notice here is in error because the Examiner is alleging, without providing any supporting evidence, that the entire "creating" action of claim 20 is well known in the art, using Applicants claimed invention and hindsight as a roadmap to assert that the "creating" claim feature was "well known in the prior art at the time of the invention." Applicants also note that with respect to one detail, the taking of official notice does not entirely focus on the claim language since it refers to a "virtual credit card" rather than a "virtual debit card," as claim 20 requires.

Therefore, Applicants respectfully submit, for the reasons stated above, that because the Office Action has failed to meet the burden of making a *prima facie* showing of obviousness. Therefore, claim 20 is allowable. It is respectfully requested the claim rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at 408-278-4053 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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Title: METHOD AND SYSTEM FOR FACILITATING SHIPPING VIA A THIRD PARTY PAYMENT SERVICE

Respectfully submitted,

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Date August 23, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23 day of August 2007.

Peter Rubini
Name

[Signature]
Signature